



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,037	12/11/2001	Ho-Shen Lin	X-12420	5683

25885 7590 08/27/2002

ELI LILLY AND COMPANY  
PATENT DIVISION  
P.O. BOX 6288  
INDIANAPOLIS, IN 46206-6288

EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>	
	10/018,037	LIN ET AL.	
	<b>Examin r</b>	<b>Art Unit</b>	
	Golam M M Shameem	1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 19,20 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19,20 and 23-26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                                              |                                                                             |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, 21-22 drawn to a compound of formula I, classified in class 548 with plethora of subclasses.
- II. Claim 19, drawn to a compound of formula II, classified in class 548 with several subclasses.
- III. Claim 20 drawn to a compound represented by the formulae C1-C11, classified in class 548 with plethora of subclasses.
- IV. Claims 23-26 drawn to a method of treating a mammal, classified in class 514 with several subclasses.

The above groups are identified as general areas. The inventions are distinct, each from the other because of the following reasons:

Invention Groups I-IV are related as a compound, its composition, and method of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1)

Art Unit: 1626

the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP 806.05(h)). In the instant case, the product as claimed could be used in a materially different process of using that product as demonstrated throughout the specification and in claims 23-26, which are directed to several different methods of using the product, for example treating a disease condition such as inflammatory diseases. Therefore a separate search considerations are involved, which would impose a burden if unrestricted. Additionally, besides performing a class/subclass search, the Examiner performs a commercial data base search and an automated patent system (text) search.

The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups, the following action is also taken.

Group I-IV comprising claims which are generic to a plurality of disclosed patentably distinct species and applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Upon the election of a single disclosed species, a generic concept inclusive of the elected species will be identified by the Examiner for examination along with the elected species.

Art Unit: 1626

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Mr. Francis Ginah on 7/29/02 to request an oral election to the above restriction requirement, and a provisional election was made with traverse to prosecute the invention of group I.

Applicants preserve their right to file a divisional on the non-elected subject matter.

#### ***Status of Claims***

Claims 1-26 are pending in this application.

In response to the restriction requirement, Applicants have elected Group I, claims 1-18 and 21-22 without traverse and drawn to a compound according to formula I and the species of the compound as shown in example 3a of page 90. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been

Art Unit: 1626

treated as an election without traverse (MPEP § 818.03(a)). Based on the election of species for the compound of example 3a, the generic concept of the compound is as follows:

A compound of formula I wherein:

R<sup>1</sup> is selected from groups (a), (b), and (c) wherein

(a) is as defined except heterocyclic radical

(b) is as claimed

(c) is as claimed

R<sup>2</sup> is claimed

R<sup>3</sup> is  $-(L_3)-Z$ , where  $-(L_3)-$  is a divalent linker group selected from a bond or divalent group selected from  $-CH_2-$ ,  $-C(=O)-$

and Z is selected from a group represented by the formula shown in page 112, lines 1-4 wherein

X is oxygen

R<sup>4</sup> is claimed

R<sup>5</sup>, R<sup>6</sup> and R<sup>7</sup> are selected from hydrogen, non-interfering substituent

As a result of the election and the corresponding generic concept identified, claims 19-20 and 23-26 and the remaining subject matter of claims 1-18 and 21-22 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 19-20 and 23-26 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

***Claim Objections***

Claims 1-18 and 21-22 are objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable. The claims must be amended to exclude non-elected subject matter and within the limit of the elected compound of formula I and all the dependent claims also, must be amended to satisfy the restriction requirement and election of species in order to place the case in condition for allowance.

Claims 2-18 and 21-22 are objected as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The Examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.


When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Art Unit: 1626

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

Golam M M Shameem, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1

August 25, 2002